

REMARKS

The foregoing response does not include the introduction of new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the present application for invention, kindly, reconsidered in view of the following remarks.

The Office Action dated August 3, 2003 has been received and considered by the Applicants. Claims 10-42 are pending in the present application for invention. Claims 10-19, 22, 23, 25, 27, 29, 31, 33, and 35 stand rejected and Claims 20, 21, 24, 26, 28, 30, 32, 34, and 36-42 are objected to by the December 4, 2003 Office Action.

The Office Action rejects Claims 10-24, 31, 32, 35, 36, 40, and 42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-8, 24 and 30-33 of U.S. Patent No. 6,370,090 (hereinafter referred to as the '90 patent) in view of U.S. Patent No. 5,592,450 issued in the name of Yonemitsu et al. (hereafter referred to as Yonemitsu et al.). The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other.

The Examiner admits that the '90 patent does not teach the additional sub-TOC having structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs. The Examiner's position is that Fig. 5 of Yonemitsu et al. teach the subject matter for an additional sub-TOC having structure storing information that can be used for determining the configuration of the same information items stored in the track area, allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs. The Applicants, respectfully, disagree.

The Applicants, respectfully, submit that Yonemitsu et al. in Fig. 5, and the description related thereto, teach creating a copy of TOC data that would be equivalent to a copy of the master TOC area as defined by the rejected claims. There is no disclosure, or suggestion, within Yonemitsu et al. that the TOC area discussed therein be used determining the configuration of the same information items stored in the track area. The Applicants would like to draw the Examiner's attention to column 11, line 56 through column 12, line 4 of Yonemitsu et al. wherein Fig. 5 is discussed. The Applicants would like to, respectfully, point out that Yonemitsu et al. discusses a TOC being placed within the lead in area and the copy of the TOC being placed in

the program area. The lead in area as discussed by Yonemitsu et al. on column 11, lines 34-55 is a separate area of the disc from the program area. The sector address of the first track of the program area is identified as address 0. In Fig. 5, Yonemitsu et al. illustrates the TOC data located within the lead in area and a copy of the TOC data being located within the program area, however, there is no discussion within Yonemitsu et al. for placing redundant copies of the TOC data within the same track. Moreover, there is no disclosure, or suggestion, within Yonemitsu et al. for placing sub-TOC data for storing information for determining the configuration of the same information items stored in the track area as recited by rejected claim 10. Therefore, there are features that are recited by rejected claim 10 that are not found within the combination made by the Examiner.

Accordingly, the rejection of Claims 10-24, 31, 32, 35, 36, 40, and 42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 22-34 of U.S. Patent No. 6,370,090, is respectfully, traversed.

The Office Action rejects Claims 10-19, 22, 23, 25, 27, 29, 31, 33, and 35 under the provisions of 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 6,198,877 issued to Kawamura et al. (hereinafter referred to as Kawamura et al.) in view of U.S. Patent No. 5,592,450, issued to Yonemitsu et al. (hereinafter referred to as Yonemitsu et al.).

The Examiner states that Kawamura et al. teach the method of rejected Claim 10 except for providing of an additional mutually logically conforming sub-TOC for the same track area in one or more track areas of a unitary storage medium and the additional sub-TOC having structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the sub-TOCs.

The Examiner states that Yonemitsu et al. in Fig. 5 teaches a recording medium providing additionally mutually logically conforming TOCs in a unitary storage medium, wherein, the additional TOCs at structures for storing information for determining the configuration of the same information items stored in the track area, thereby allowing retrieving the configuration of the same information item in the track area from at least any correct copy of the TOCs. The Applicants would like to draw the Examiner's attention to column 11, line 56 through column 12, line 4 of Yonemitsu et al. wherein Fig. 5 is discussed. The Applicants would like to, respectfully, point out that Yonemitsu et al. discusses a TOC being placed within the lead in area and the copy

of the TOC being placed in the program area. The lead in area as discussed by Yonemitsu et al. on column 11, lines 34-55 is a separate area of the disc from the program area. The sector address of the first track of the program area is identified as address 0. In Fig. 5, Yonemitsu et al. illustrates the TOC data located within the lead in area and a copy of the TOC data being located within the program area, however, there is no discussion within Yonemitsu et al. for placing redundant copies of the TOC data within the same track. Moreover, there is no disclosure, or suggestion, within Yonemitsu et al. for placing sub-TOC data for storing information for determining the configuration of the same information items stored in the track area as recited by rejected claim 10. Therefore, there are features that are recited by rejected claim 10 that are not found within the combination made by the Examiner.

The Examiner states that Yonemitsu et al. teach the advantages of making a duplicate copy of the TOC file, and that Kawamura et al. teach a master TOC that refers to a sub-TOC and that it would have been obvious for person of ordinary skill within the art to create the storage medium as defined by rejected claim 10 to the present invention. The Applicants, respectfully, disagree. The combination of Yonemitsu et al. with Kawamura et al. made in the Final Office Action would logically result a master TOC in the entry level of the disc with a copy of the master TOC somewhere in the program area and at most a single sub-TOC in each discrete part of the program area. Rejected claim 10 recites the elements of providing at least two mutually logically conforming sub-TOCs for the same track area in one or more track areas of a unitary storage medium, and providing at least one master-TOC having structures for storing information for determining the position of the sub-TOCs. There is no disclosure, or suggestion, in either Yonemitsu et al. or Kawamura et al. for implementing redundant sub-TOCs as recited by rejected claim 10. Therefore, there are features within rejected Claim 10 that are not found the combination made by the Final Office Action.

As stated in the MPEP at §2142, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Regarding the first point above, that there must be some suggestion or motivation, to make the combination provided by the prior art, the Applicants, respectfully, point out that the Office Action does not provide any suggestion or motivation within the cited prior art references to make the combination made in the Office Action. The Examiner states that a person skilled in the art would be motivated to make the combination made by the Office Action because some computer applications do not easily recognize data recorded in the sectors having negative addresses. The Applicants, respectfully point out that the rationale given by the Examiner is the rationale given by Yonemitsu et al. for making redundant TOC areas and does not provide any suggestion or motivation for making redundant sub-TOC areas.

The Applicants would like to, once again, draw the Examiner's attention to column 11, line 56 through column 12, line 4 of Yonemitsu et al. wherein Fig. 5 is discussed. The rationale for providing a redundant master TOC by Yonemitsu et al. is because some computer applications do not easily recognize data recorded in sectors having negative addresses. This teaching of Yonemitsu et al. may suggest creating redundant files in the lead in area and the program area, however, it does not suggest creating redundant sub-TOCs for determining the configuration of the same items stored within a track area as recited by rejected Claim 10. There is no suggestion provided by Yonemitsu et al. for creating redundant structures for determining the configuration of the same information stored in a track area.

The specification to the present application for invention on page 8, lines 22-26 provides the motivation for creating redundant files within the same track to overcome interference through environmental and other influences. Kawamura et al. provides no redundancy at all.

Regarding a reasonable expectation of success that must be found in the prior art, and not based on Applicants' disclosure. The Final Office Action has failed to provide any support within either Kawamura et al. or Yonemitsu et al. that it is possible to read a second sub-TOC in a track after a failure in attempting to read a first sub-TOC in the same track. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In order to establish a *prima facie* case of obviousness, there must be a reasonable expectation of success found within the prior art, and there has not been any reasonable expectation of success within the prior art provided by the Final Office Action.

As previously stated, even though a hindsight approach has been employed in making the combination, there still remain recited claim elements that are not found in the combination made by the Office Action. The Office Action has not provided any indication, desire or usefulness of providing redundant structures indicative of the same information within a track from either of the prior art references. Moreover, the Office Action has not provided suggestion for the usefulness of providing redundant sub-TOC files indicative of the same information within a track. Accordingly, the rejection to Claim 10 contained within the final office action is, respectively, traversed.

Regarding Claims 11-15, these claims depend from and further narrow and define Claim 10. Therefore since Claim 10 is believed below for the above discussed reasons claims 11-15 are also believed to be allowable.

Regarding claim 16, the Examiner states that Kawamura et al. teach the features of rejected claim 16, specifically, the Examiner states that Kawamura et al. teach two sub-TOCs assigned to the same track area. The Applicants unequivocally deny this assertion contained within the Office Action. Kawamura et al. do not teach or suggest two sub-TOCs assigned to the same track area. Accordingly, this rejection is, respectfully, traversed.

Regarding Claim 17, Examiner states that Yonemitsu et al. teach two sub-TOC files assigned to the same area is exactly two. The Applicants, respectfully, disagree. Yonemitsu et al. do not teach two sub-TOC files, Yonemitsu et al. teach redundant master TOC files. The Applicants, respectfully, point out that the Examiner has modified the combination in order to reach the elements recited by the rejected claims. As previously discussed, the Examiner must provide some rationale within the cited prior art to substantiate the modification of the combination made by the Office. No such rationale provided by the Office Action. Accordingly, this rejection is respectfully traversed.

Regarding Claim 19, Examiner states that Yonemitsu et al. teach the sub-TOC files are identical. The Applicants, respectfully, disagree. Yonemitsu et al. do not teach identical sub-TOC files, Yonemitsu et al. teach redundant master TOC files. The Applicants, respectfully, point out that the Examiner has modified the combination in order to reach the elements recited by the rejected claims. As previously discussed, the Examiner must provide some rationale within the cited prior art to substantiate the modification of the combination made by the Office. No such rationale provided by the Office Action. Accordingly, this rejection is respectfully

traversed.

Regarding apparatus Claims 22 and 23, the Examiner states that these claim are rejected for the reasons as Claims 10, 11 and 13. Therefore, the Applicants' traverse the rejection to Claims 22 and 23 for the same reasons as Claims 10, 11 and 13 above.

Regarding apparatus Claim 25, the Examiner states that this claim is rejected for the reasons as Claim 10, 11 and 13. Accordingly, the Applicants traverse the rejection to Claim 25 for the same reasons as Claims 10, 11 and 13 above. The Examiner further states that Claim 25 recites first control means for positioning a read head and second control means for positioning the read head are rendered obvious by the disc drive and controller of Yonemitsu et al. The Applicants, respectfully, disagree. The Examiner has provided no support for the assertion that disc drive and controller of Yonemitsu et al. can function as different control means for positioning a read head. Accordingly, this rejection is, respectfully, traversed.

Regarding apparatus Claim 27, the Examiner states that this claim is rejected for the same reasons as Claims 10, 11 and 13. Therefore, the Applicants traverse the rejection to Claim 27 for the same reasons as Claims 10, 11 and 13 above. The Examiner further states that Claim 27 recites first control means for positioning a read head and second control means for positioning the read head are rendered obvious by the disc drive and controller of Yonemitsu et al. The Applicants, respectfully, disagree. The Examiner has provided no support for the assertion that disc drive and controller of Yonemitsu et al. can function as different control means for positioning a read head. Accordingly, this rejection is, respectfully, traversed.

Regarding apparatus Claims 29 and 33, the Examiner states that these claims are rejected for the reasons as Claims 10, 11 and 13. Accordingly, the Applicants traverse the rejection to Claims 29 and 33 for the same reasons as Claims 10, 11 and 13 above.

Regarding apparatus Claim 31, the Examiner states that these claim are rejected for the reasons as Claims 10, 11 and 13. Therefore, the Applicants traverse the rejection to Claim 31 for the same reasons as Claims 10, 11 and 13 above.

Regarding apparatus Claim 35, the Examiner states that this claim is rejected for the reasons as Claims 10, 11 and 13. Therefore, the Applicants traverse the rejection to Claim 35 for the same reasons as Claims 10, 11 and 13 above.

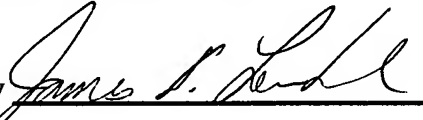
The Office Action objects to Claims 20, 21, 24, 26, 28, 30, 32, 34, and 36-42 as being

dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As previously discussed, the base claims from which Claims 20, 21, 24, 26, 28, 30, 32, 34, and 36-42 depend are believed to be allowable over the cited references. Therefore, Claims 20, 21, 24, 26, 28, 30, 32, 34, and 36-42 which further narrow and define the base claims from which they depend are also believed to be allowable.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

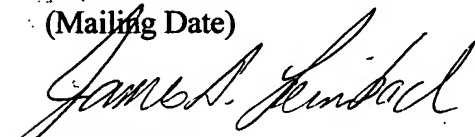
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CERTIFICATE OF MAILING

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on: November 3, 2004

(Mailing Date)


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